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Filing Date	March 13, 2000
First Named Inventor	Peter Chaikowsky
Art Unit	3724
Examiner Name	B. Ashley

Total Number of Pages in This Submission

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Attorney Docket Number

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Adan Ayala, Esq.

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March 3, 2004

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H 144 B 11/04
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UTILITY PATENT

B&D No. P-TN-1698

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Peter CHAIKOWSKY

Serial No.: 09/524,076

Examiner: B. Ashley

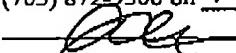
Filed: March 13, 2000

Group Art Unit: 3724

For: MITER SAW

Assistant Commissioner for Patents
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I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence
is being facsimile transmitted to the Patent and Trademark Office Fax No.
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Adan Ayala

Dear Sir:

This is in response to the Office action of January 8, 2004.

No claims have been amended. Currently in the above-identified application therefore are

Claims 1-11.

The Examiner has rejected Claims 8-11 under 35 USC §112, second paragraph for
indefiniteness. This rejection is respectfully traversed.

In particular, the Examiner questions how Claims 8-11 further limit Claim 7. Claim 7
calls for the distance between the fence and the second endpoint to be at least 1.1 times the
radius. Claim 8 further defines that such distance be at least about 1.236 to about 1.252 times the
radius.

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The Examiner has asked "how can the distance be at least 1.1 and also at least 1.236?"

The Examiner is reminded that the primary purpose of 35 USC § 112, second paragraph, is "to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." MPEP § 2173, at 2100-198 (8th ed., rev. 1, Feb. 2003).

In other words:

In reviewing a claim for compliance with 35 USC § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and therefore, serves the notice function required by 35 USC § 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent.

MPEP § 2173.02, at 2100-199 (*citing Solomon v. Kimberly-Clark Corp.*, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Applicant submits that Claim 8 apprises a person skilled in the art of its scope and provides clear warning as to what constitutes infringement of the patent. Why? Because a person skilled in the art would understand that, if an independent claim calls for a number larger than 1 and a dependent claim calls for a number larger than 10, all numbers that meet the claimed recitation in the dependent claim (such as 11, 12, 13, ...) will also be larger than 1. Such person will also recognize that number 9 may fall within the broader range of the independent claim, but outside the narrower range of the dependent claim.

Similarly, Claim 8 calls for a distance of at least about 1.236. This range is smaller than that provided by Claim 7. A person skilled in the art will recognize that a distance of 1.5 will infringe both Claims 7-8. The same person will recognize that a distance of 1.1 will infringe

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Claim 7, but not Claim 8. Therefore, Claim 8 provides clear warning to others as to what constitutes infringement of the patent. Accordingly, Claim 8 is definite.

For the sake of brevity, Applicant submits that the Examiner can apply this same analysis to Claim 9-11 and discover that Claims 9-11 are also definite for the same reasons. Applicant invites the Examiner to contact Applicant's attorney if the Examiner requires some assistance on such matter.

The Examiner has rejected Claims 1-11 under 35 USC § 103(a) as unpatentable over DE 197 06 408 ("DE '408"). This rejection is respectfully traversed.

Claim 4 calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, a fence attached to the base assembly for supporting a workpiece and having a fence plane, the table having a table plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane, wherein distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius, and distance between the first axis and the blade center is about 1.882 times the radius.

Admittedly, DE '408 shows a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, the table having a table plane, a fence connected to the base assembly and having a fence plane, a saw assembly including a motor and a blade driven by

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the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane. However, based on Figure 3 of DE '408, the distance between the first axis and the table plane is 0.57 times the radius and the distance between the first axis and the fence plane is 0.927 times the radius.

By contradistinction, Claim 4 calls for the "distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius."

The Examiner argues that it would be obvious to modify DE '408 to obtain such specific dimensions. Admittedly, differences in ranges will not support the patentability of the claimed subject matter "unless there is evidence that such [range] is critical." See MPEP § 2144.05(II)(A), at 2100-138. In fact, the "law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims In such a situation, the applicant must show that the particular range is critical generally by showing that the claimed range achieves unexpected results relative to the prior art range." MPEP § 2144.05(II), at 2100-138. Evidence of unexpected results (and thus of nonobviousness) includes evidence of superiority of a property shared with the prior art. MPEP § 716.02(b), at 700-240. Similarly, evidence of a property not possessed by the prior art is evidence of nonobviousness. Id.

In the present case, having an arrangement with the claimed dimensions is critical because a miter saw with such dimensions can cut certain desired workpiece with a smaller blade that

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were not previously achievable. As evidenced by the previously-submitted declaration of Peter Chaikowsky, a ten-inch miter saw according to the present invention can cut both a 6.5" by $\frac{3}{4}$ " workpiece and a dimensional 4" by 4" workpiece without requiring changing the position of the fence plane. By comparison, DE '408 discloses a ten-inch miter saw that, while it certainly can cut a 6.5" by $\frac{3}{4}$ " workpiece as shown in Figure 5. To cut a 4" by 4" workpiece, however, the user needs to change the position of the fence plane. Such step is not necessary in the ten-inch miter saw according to Claim 4.

The ability to cut the certain desired workpieces described above without moving the position of the fence plane forwardly or rearwardly to accommodate a different-sized workpiece is a property not possessed by DE '408. Furthermore, the ability to cut a dimensional 4" by 6" workpiece with a ten-inch blade is a property superior to the prior art. Under the MPEP, these facts are evidence of nonobviousness over DE '408. Therefore Claims 4-11 are allowable over DE '408.

The Examiner also rejected Claims 1-2 and 4-6 under 103(a) as being unpatentable over US Patent No. 5,063,802 ("Shiotani") in view of DE '408. This rejection is respectfully traversed.

Admittedly, Shiotani shows a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, the table having a table plane, a fence connected to the base assembly and having a fence plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the

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table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane.

The Examiner has admitted that Shiotani does not disclose the claimed distances between the first axis and the table plane and between the first axis and the fence plane. To make up for such deficiency, the Examiner relies on DE '408, which shows the distance between the first axis and the table plane is 0.57 times the radius and the distance between the first axis and the fence plane is 0.927 times the radius.

By contradistinction, Claim 4 calls for the "distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius." Even if Shiotani and DE '408 were to be combined, such combination does not have all the claimed elements.

The Examiner argues that it would be obvious to modify DE '408 to obtain such specific dimensions. Admittedly, differences in ranges will not support the patentability of the claimed subject matter "unless there is evidence that such [range] is critical." See MPEP § 2144.05(II)(A), at 2100-138. In fact, the "law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims In such a situation, the applicant must show that the particular range is critical generally by showing that the claimed range achieves unexpected results relative to the prior art range." MPEP § 2144.05(II), at 2100-138. Evidence of unexpected results (and thus of nonobviousness) includes evidence of superiority

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of a property shared with the prior art. MPEP § 716.02(b), at 700-240. Similarly, evidence of a property not possessed by the prior art is evidence of nonobviousness. Id.

In the present case, having an arrangement with the claimed dimensions is critical because a miter saw with such dimensions can cut certain desired workpiece with a smaller blade that were not previously achievable. As evidenced by the previously-submitted declaration of Peter Chaikowsky, a ten-inch miter saw according to the present invention can cut both a 6.5" by $\frac{3}{4}$ " workpiece and a dimensional 4" by 4" workpiece without requiring changing the position of the fence plane. By comparison, DE '408 discloses a ten-inch miter saw that, while it certainly can cut a 6.5" by $\frac{3}{4}$ " workpiece as shown in Figure 5. To cut a 4" by 4" workpiece, however, the user needs to change the position of the fence plane. Such step is not necessary in the ten-inch miter saw according to Claim 4.

The ability to cut the certain desired workpieces described above without moving the position of the fence plane forwardly or rearwardly to accommodate a different-sized workpiece is a property not possessed by Shiotani or DE '408. Furthermore, the ability to cut a dimensional 4" by 6" workpiece with a ten-inch blade is a property superior to the prior art. Under the MPEP, these facts are evidence of nonobviousness over Shiotani and DE '408. Therefore Claims 1-2 and 4-6 are allowable over Shiotani and DE '408.

Applicant has noticed that the Examiner has not provided any comments on the previously-submitted declaration of Peter Chaikowsky. Applicant requests that the Examiner comment on the facts posited by Mr. Chaikowsky. Otherwise, Applicant requests that the Examiner accept Mr.

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Chaikowsky's assertions. If the Examiner has accepted Mr. Chaikowsky's assertions, Applicant would like an explanation of why the Examiner continues to disregard Mr. Chaikowsky's assertions evidencing nonobviousness.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-11 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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